

REMARKS

Claims 1-3, 6-10, 13-15, and 18-21 are pending. Claims 7, 15, and 21 have been withdrawn from consideration as being directed to a non-elected invention.

Claims 18-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Publ. No. 2003/0173363 ("Miller, Jr. et al."). Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application GB 2,098,958 ("Taylor et al."). Claims 8-10, 13, and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor et al. in view of U.S. Patent No. 3,804,289 ("Churan").

Applicant has amended claim 18 to further define the invention. Specifically, Applicant has amended claim 18 to further define the upper and the lower sections of the body being absent of any openings that would otherwise allow fluid to flow out of the partially hollow interior of the body when the upper and lower sections are joined together. As noted above, the Examiner had rejected claims 18-20 as being anticipated by Miller, Jr. et al., which describes a recycling container and method of manufacturer therefor. As best shown in FIGS. 1, 2, and 5 of the Miller, Jr. et al. patent, the recycling container consists of a receptacle (5) and a cover (3) that fits onto the receptacle to define an interior cavity that can be used to stow recycling materials. A multi-flap door (33) is formed in the cover that allows a user to place recyclable materials into the recycling container without removing the cover from the receptacle. As best shown in FIG. 5, cuts are formed in an otherwise solid membrane to form flaps. These cuts, in effect, form spaces or gaps in the membrane that allow the flaps to deform when a recyclable product is inserted through the door. While these cuts enable limited deformation of the flaps, one skilled in the art would also

appreciate that these same cuts would allow fluid to pass out of the container if such fluid, i.e., water, was loaded into the container. In this regard, Miller, Jr. et al. fails to teach or suggest a device such as that recited in claims 18-20. As described in the present application, one application of the claimed invention is as a chilling device for chilling food products, such as soups. In this regard, it is important that the chilling fluid not escape from the chilling device and contaminate the food being chilled. One skilled in the art would readily recognize that the recycling container described by Miller, Jr. et al. would be incapable of performing such a function. Thus, not only is the recycling container of the prior art dissimilar in structure from the claimed invention, but the recycling container cannot function in a manner similar to the claimed invention without significant modifications to the recycling container. Moreover, given that the door is required for the recycling container to operate as intended, sealing the door to prevent the ingress/egress of fluid would appear to render the recycling container inoperable for its intended purpose. Accordingly, it is submitted that the invention recited in claims 18-20 is patentably distinct from that taught and/or suggested by Miller, Jr. et al. Allowance of claims 18-20 is therefore requested.

The Examiner also reiterated the previous rejections of claims 1-3, 6, 8-10, 13, and 14 as being unpatentable, in whole or in part, over Taylor et al. Accordingly, Applicant incorporates herein the remarks previously presented. Specifically, Taylor et al. discloses a dispenser for dispensing personal care or household items, especially liquid soap. See Abstract. With reference to FIG. 2, Taylor et al. teaches a cylindrically shaped bottle 12 having a planar base 32 and a frustoconical top 40 that has an opening 36 formed an upper end thereof. A valve 30 cap threads onto the upper end of the top 40 to close the opening 36. The valve cap 30 may be opened when the bottle 12 is squeezed to allow fluid, e.g., liquid soap, to be dispensed from the bottle.

Taylor et al. further teaches a storage cap 14 having inwardly directed lip 20 that may engage an annular groove 24 formed in the bottle 12 adjacent the top 40. The lip 20 and the annular groove 24 allow the storage cap 14 to be snap-fit onto the bottle 12 when the bottle 12 is being sold and shipped for “protect[ing] valve cap 30 and function as a protective closure of bottle 12.” See p. 3, ll. 30-34. The lower end of the bottle 12 also includes a cap fastening groove 26. In this regard, “[w]hen use of the bottle commences, hanger and storage cap 14 is removed from its snap-fit position at one end of the bottle 12 and is placed at the opposite end with lip 20 in cap fastening groove 26.” P. 3, ll. 34-38. In other words, the reference teaches that the storage cap 14 provides two explicit functions, (1) it protects the valve cap 30 during shipment and when the bottle 12 is being displayed for purchase and (2) it facilitates hanging of the bottle 12 from a shower curtain rod or tap stem during use.

Taylor teaches a dispenser for liquid. The invention is, instead, directed to a chilling device. This distinction in and of itself is significant in that the two devices are used and function in two completely environments for two completely different purposes. The Examiner has asserted that the valve cap 14 and the storage cap 30, for purposes of applying the reference against the claims of the instant application, constitute a single structure that closes the opening 36 in the bottle 12. The Examiner has taken this position despite the reference explicitly teaching that the valve cap 30 and the storage cap 30 are separate components and this separation is required for the storage cap 14 to function as described. For example, the reference states:

The container of the invention is in the form of a bottle...The bottle is fitted with a cap which includes a valve...The bottle is also fitted with a storage and hanger cap. This is a generally hook-shaped cap fastened over the valve cap during shipping and storage, but fastenable also at the bottom end of the bottle to permit the bottle to be

hung in inverted fashion from a shower-head pipe, shower curtain rod, or any other suitable place.

GB 2,098,958, p. 1, ll. 51-67.

The reference further indicates that the invention comprises “a valved cap mounted over said aperture [of the bottle] to effect selectable closure of said bottle; and a hook-shaped cap adapted to be fastened over either end of said top or bottom [of the bottle].” Id. at p. 1, ll. 47-50. As can be seen, the valve and cap are two entirely separate and distinct components with each required to perform a completely different function. As such, Applicant submits that the Examiner has failed to establish any basis for considering the valve cap 14 and the storage cap 30 as a single structure. The reference does not show the two caps as being integrally formed with or otherwise connected to one another. As noted above, for the bottle of Taylor et al. to work as intended, the storage cap 30 must be removable from the bottle 12 without removing the valve cap 14. Moreover, it is the valve cap 14 that seals the bottle 12. The storage cap 30 does not perform this function and one of skill in the art would not expect it to so function given the device’s design. Indeed, without the benefit of hindsight reconstruction, it strains credulity to suggest that one skilled in the art would take a liquid soap dispenser consistent with that described in the reference and modify it to create a chilling device having a cap with an integral expansion volume.

For the construction proposed by the Examiner to work, significant changes would need to be made to the dispenser described by Taylor et al. For instance, Taylor et al. teaches that when the dispenser is in use, the storage cap is attached to the bottom of the bottle. If the valve cap were coupled to the storage cap, moving the storage cap to the in-use position would leave the opening of the bottle exposed and when the bottle is hung using the hanger of the storage cap, fluid

would flow freely out of the bottle. Moreover, there is no recess or any other structure to permit the valve cap and the storage cap to be paired together such that the storage cap can be snap-fit onto the bottle. In short, there is no support in the reference whatsoever to support the position that the storage cap and the valve cap are, or could be, a single structure.

In response to Applicant's arguments, the Examiner now contends that the storage cap of Taylor et al. is considered to anticipate the claimed cover, "not the combination of valve cap 30 and storage cap 14." That is, the Examiner has now asserted that one skilled in the art would have removed and discarded the valve cap of the bottle explicitly disclosed by Taylor et al. and used the resulting structure (namely; planar base 32 and a frustoconical top 40) as a fluid containment device. This interpretation of Taylor et al. ignores that Taylor et al. explicitly teaches the storage cap as a device that is to be removed and snapped onto the opposite end of the planar base so that the bottle can be hung, such as on a shower head or shower curtain rod. So while the storage cap is capable of fitting on either end of the base, the storage cap is not disclosed as "closing the device of Taylor" and there is nothing to suggest that it would provide the fluid tight seal necessary in the claimed invention. The valve-cap is described as closing the device. The storage cap provides protective cover for the valve cap during shipping but during use, the storage cap is removed and affixed to the opposite end of the base, which enables the bottle to be hung upside-down from a shower curtain rod, for example. One skilled in the art would thus appreciate that removing the valve cap would result in a non-functioning liquid container. That is, the liquid, e.g., shampoo or soap, would pour out of the container when the container was used as intended, i.e., hung upside down. Clearly then, the valve cap is an integral component of the bottle described by Taylor et al.

and one skilled in the art would appreciate as much and would not, without hindsight, modify it to create Applicant's claimed invention.

Additionally, the Examiner has not provided any rationale or factual support thereof as to why one skilled in the art would have found it beneficial or necessary to modify the soap bottle described by Taylor et al. and then use such a modified bottle as a chilling device. As described previously, the valve cap is an integral component of the Taylor et al. bottle and without it the bottle would not function properly. Moreover, the Examiner has not established that if one skilled in the art were motivated to use the soap bottle disclosed by Taylor et al., he would have modified the bottle to remove the valve cap. There has been no disclosure in the art of record that the valve capped-bottle disclosed by Taylor et al. could not be used as-is for chilling or, on the flip side, that it could or would be used as a chilling utensil in any form.

Accordingly, Applicant respectfully submits that rejection of the claimed invention under 35 U.S.C. § 103(a) is improper because the Examiner has not made a proper showing that the factual inquiries of Graham have been made. An Examiner must provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* And, an Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." *Id.* Applicant submits that anything less than such an explicit analysis is insufficient to support

a prima facie case of obviousness. See also MPEP §2143. Applicant submits that prima facie obviousness has not been established because the Examiner has not performed the analysis required by *KSR* necessitating reversal of the claim rejections.

Moreover, while the Supreme Court in *KSR* identified several rationales that could be used to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*, §2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render a claim unpatentable, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted references must also teach or suggest each and every claim feature. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (to establish prima facie obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Thus, “obviousness requires a suggestion of all limitations in a claim,” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)), regardless of which rationale has been used to support a conclusion of obviousness.

Further, even assuming that each of the references cited by the Examiner generally discloses various elements of the claimed invention, and further assuming that the mechanical aptitude required to make the purported modifications would generally be possible to one skilled in the art, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Additionally:

Even though the components are known, the combining step is technically feasible, and the result is predictable, the claimed invention may nevertheless be nonobvious when the combining step involves such additional effort that no one of ordinary skill would have undertaken it without a recognized reason to do so. When a combination invention involves additional complexity as compared with the prior art, the invention may be nonobvious unless an examiner can articulate a reason for including the added features or steps. This is so even when the claimed invention could have been readily implemented.

Federal Register, vol. 75, no. 169, September 1, 2010, p. 53646. Thus, more than the possibility and predictability of combining known elements is required to sustain an obviousness rejection. There must be an articulation of some reason to do so that is consistent with basic economic and engineering considerations. In the simplest terms, the Examiner has not articulated any reason whatsoever as to why one skilled in the art would have modified the bottle disclosed in the Taylor et al. patent and that such a modification would have necessarily included consideration of the construction of the claimed invention.

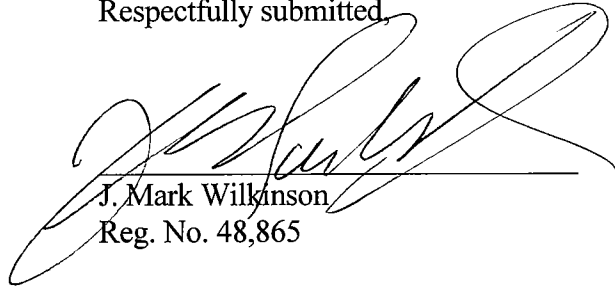
Therefore, in light of at least the foregoing, it is submitted that the art of record neither teaches nor suggests that recited in claims 1-3, 6-10, 13-15, and 18-21. As such, the claims are believed to define the invention in a manner that is neither taught nor suggested by the art of record. A Notice of Allowance for claims 1-3, 6-10, 13-15, and 18-21 is therefore requested.

Applicant believes that there are no fees due in connection with this communication. Nevertheless, authorization is given to charge any additional fees or credit any overpayment in connection with this or any future communication to the Deposit Account No. 50-1170.

Serial No.:10/594,942
Inventor(s): Omdoll et al.
Title: *Chilling Utensil and Method of Use*
Docket No.: 1414.093

The Examiner is invited to contact the undersigned by telephone if it would help
to expedite matters.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Mark Wilkinson', is written over a horizontal line.

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